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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)
		000309.0257
	Application Number 10/735,808	Filed December 16, 2003
	First Named Inventor Jay MIAZGA et al.	
	Art Unit 1732	Examiner Not Yet Assigned
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 28,419</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p>_____ Signature Michael C. Greenbaum Typed or printed name (202) 772-5800 Telephone number December 11, 2007 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of 1 forms are submitted.</p>		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Jay MIAZGA et al.

Serial No.: 10/735,808

Filed: December 16, 2003

FOR: METHODS FOR MANUFACTURING
A FLEXIBLE SUPPORT MEMBER

Confirmation No.: 2863

Art Unit: 3766

Examiner: Brian T. Gedeon

Docket No.: 000309-00257

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to October 4, 2007 final Office Action, Applicants respectfully request a pre-appeal brief review.

In the October 4, 2007 Office Action, claims 39, 40, 42, 48, 53, and 63 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Martineau, claims 43 and 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Martineau in view of Advanced Elastometer Systems Product Page, claims 44, 45, 47, 57, 58, 60-62, and 65 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bishay et al. and further in view of Martineau, claims 54-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Martineau in view of Rowley, claims 52 and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Martineau in view of Bishay et al., and claim 59 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bishay et al. in view of Martineau and further in view of Rowley.

The rejections over prior art are respectfully traversed. In summary, neither Martineau nor Bishay et al., either alone or in combination, discloses, teaches, suggests or renders obvious a method for manufacturing a flexible carrier including the step of positioning at least a portion of a flexible member in a channel having at least one lip positioned toward an opening of the channel to at least partially retain the flexible member, as recited in independent claim 39, or a method of manufacturing a flexible support member including the step of disposing a second quantity of elastic material so that the surfaces of its first and second portions are generally coplanar, as recited in independent claim 44. The

prior art also fails to teach a method for manufacturing a support member including the steps of positioning at least a portion of a first elongate flexible member in a first channel, and also positioning at least a portion of an elongate deformable a member in the first channel, as recited in independent claim 48. Each rejection is addressed in detail below.

Claim Rejections - 35 U.S.C. § 102

Claims 39, 40, 42, 48, 53 and 63 are rejected under 35 U.S.C. § 102(b) as being anticipated by Martineau. However, Martineau fails to disclose all of the claim limitations of either independent claim 39, as amended, or independent claim 48.

Independent claim 39, as amended, recites among other steps forming a first portion of the flexible carrier having a channel and positioning at least a portion of a flexible member in the channel having at least one lip positioned toward an opening of the channel to at least partially retain the flexible member in the channel. Martineau, in contrast, does not teach forming a lip positioned toward the opening of the channel. Martineau discloses a method of fabricating a flexible fuel tank that includes upper and lower halves 1 and 2, as seen in Figure 1. The method includes injecting an elastomer into a cavity formed between a core 3 and a stamp 5, as seen in Figure 3. The stamp 5 is removed and a rubber cord 4 is positioned in a peripheral depression 6, as seen in Figure 4A. No portion of the peripheral depression 6 includes a lip to at least partially retain the rubber cord 4 in the depression 6. Also, the peripheral depression 6 of Martineau cannot be both the channel and the lip of the claimed invention, as suggested in the Office Action.

Anticipation requires that every limitation of a claim must identically appear in a prior art reference. See *Gechter v. Davidson*, 43 U.S.P.Q. 2d 1030, 1032 (Fed. Cir. 1997). It is clear that the step of positioning at least a portion of the flexible member in the channel having at least one lip positioned toward an opening of the channel to at least partially retain the flexible member in the channel does not identically appear in Martineau. Absence from the prior art reference of any claimed element negates anticipation. See *Rowe v. Dror*, 42 U.S.P.Q.2d 1550, 1553 (Fed. Cir. 1997).

Therefore, because a channel with a lip is not identically found in Martineau, Martineau fails to anticipate independent claim 39.

Independent claim 48 recites among other steps forming a first channel, positioning at least a portion of a first elongate flexible member in the first channel, and positioning at least a portion of an elongate deformable member in the first channel. Martineau fails to teach or

suggest positioning both a flexible member and a deformable member in a channel of a support member. Instead, Martineau teaches placing a *single* rubber cord 4 in the peripheral depression 6. No other cord is placed in the depression 6 and the single rubber cord 4 of Martineau cannot be both the flexible member and the deformable member of independent claim 48.

Therefore, because both an elongate flexible member and an elongate deformable member are not identically found in Martineau, Martineau fails to anticipate independent claim 48.

Dependent claims 40-43, 50-56, and 63-65 are also allowable over Martineau for the same reasons discussed with respect to their independent claims 39 and 48. Moreover, those claims recite additional features not found in Martineau. For example, dependent claim 41 recites among other steps compressing at least a part of the first portion against the second mold assembly to seal the channel and contain the at least partially uncured second quantity of elastic material in the channel during curing of the second quantity of elastic material. Also, dependent claim 42 recites positioning at least a portion of a deformable member in the channel. Dependent claim 53 recites that the lip extends inwardly into the channel (as seen in Figs. 35A-35C). Dependent claim 63 recites that the support member includes forming the first portion in a U shape with the first channel and the deformable member each having at least a generally similar U shape. And, claim 65 recites that the channel includes a lip to at least partially retain the flexible member.

Accordingly, Applicants request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) over Martineau.

Claim Rejections - 35 U.S.C. § 103

Claims 44, 45, 47, 57, 58, and 60-62 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bishay et al. in view of Martineau. A prima facie case of obviousness has not been established because all of the claim limitations of independent 44, as amended, are not found in Bishay et al., Martineau, or any combination thereof.

Independent claim 44 recites a method for manufacturing a flexible support member including, among other steps, disposing a second quantity of elastic material in the channel to form a second portion of the support member so that the second surface of the second portion is at least generally coplanar with the first surface of the first portion. None of Bishay et al., Martineau, or any combination thereof teach disposing a second quantity of elastic material in

the channel to form a second portion of the support member so that the second surface of the second portion is at least generally coplanar with the first surface of the first portion, as recited in independent claim 44 as amended.

Bishay et al. teaches a basic support member 220 that is formed with an upper portion 210, a cable channel 212, and a lower portion 211. However, Bishay et al. does not teach that the surfaces of the upper and lower portions 210 and 211 are generally coplanar. Instead, the upper and lower portions 210 and 211 rest on top of one another and therefore cannot be coplanar.

And Martineau fails to cure the deficiencies of Bishay et al. The first and second half shells 1 and 2 of Martineau are molded one on top of the other to form the tank. Thus, none of the surfaces of the shells 1 and 2 can be coplanar with respect to one another.

Therefore, neither Bishay et al. nor Martineau, or any combination thereof discloses forming the support member so that the surfaces of the first and second portions of the support member are generally coplanar, as recited in independent claim 44. Accordingly, Applicants request reconsideration and withdrawal of the rejection of independent claim 44 under 35 U.S.C. § 103(a) as being unpatentable over Bishay et al. in view of Martineau.

Dependent claims 45, 47, and 57-62 are also allowable for the same reasons discussed above with respect to independent claim 44. Moreover, those claims recite additional features not found in the prior art.

Also, dependent claim 60 recites that in the formation of the second portion of the support member the second quantity of elastic material is injected into the first channel. In contrast, the shells 1 and 2 of Martineau are merely molded onto one another with a void in between. And dependent claim 61 recites positioning at least a portion of a deformable member in the first channel. Bishay et al. fails to teach any type of deformable member, and Martineau teaches only a single rubber cord 4.

Claims 41 and 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Martineau. However, as discussed above with respect to independent claim 39, Martineau fails to disclose all of the limitations of the claimed invention. Therefore, a prima facie case of obviousness has not been established with respect to dependent claims 41 and 51.

Claims 43 and 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Martineau in view of an Advanced Elastomer Systems Product Page. As outlined above with respect to independent claims 39 and 48, Martineau fails to disclose all of the claim limitations of either independent claim. And the Advanced Elastomer Systems Product Page

fails to cure the deficiencies of Martineau. The product page is merely cited for teaching a thermal plastic elastomer that has a durometer of 50 Shore D. Therefore, a prima facie case of obviousness has not been established with respect to dependent claims 43 and 50.

Claims 54-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Martineau in view of Rowley. As outlined above, Martineau fails to disclose positioning at least a portion of a flexible member in the channel having at least one lip, as recited in independent claim 39. Rowley fails to cure the deficiencies of Martineau. Rowley is merely cited for teaching forming a plumbing connector. Therefore, a prima facie case of obviousness has not been established with respect to dependent claims 54-56.

Claims 52 and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Martineau in view of Bishay et al. As discussed above, Martineau fails to disclose all of the claim limitations of either independent claims 39 or 48. Also, Bishay et al. fails to cure the deficiencies of Martineau. Therefore, even if Martineau and Bishay et al. could be combined, the combination fails to disclose all of the claim limitations of independent claims 39 and 48.

Claim 59 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bishay et al. in view of Martineau and further in view of Rowley. As outlined above, neither Bishay et al. nor Martineau, or any combination thereof, teaches all of the claim limitations of independent claim 44. Also, Rowley fails to cure the deficiencies of Bishay et al. and Martineau. Therefore, a prima facie case of obviousness has not been established with respect to dependent claim 59.

Accordingly, Applicants request reconsideration and withdrawal of the rejection of claims 41, 43, 51-56, 59 and 64 under 35 U.S.C. § 103(a).

In view of the foregoing, Applicants believe that claims 39-45, 47, 48, and 50-65 are in allowable condition. Prompt and favorable action is respectfully solicited.

Respectfully submitted,

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Michael C. Greenbaum
Registration No. 28,419

BLANK ROME, LLP
600 New Hampshire Avenue, N.W.
Washington, D.C. 20037
(202) 772-5800 (Phone)
(202) 772-5858 (Facsimile)